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EXAMINER

MENBERU, BENIYAM

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,583

Applicant(s)

LEONARDI, RICCI J.

Examiner

Beniyam Menberu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS; WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-14 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see Remarks, filed September 27, 2006, with respect to the rejection(s) of claim(s) 1-7, 13-16, 23 and 24 under Tung et al. (US 5803498) in view of Yuyama et al (US 5839836) and further in view of Alexander et al. (US 6179202 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6304849 to Uecker et al.

2. Applicant's arguments, see Remarks, filed September 27, 2006, with respect to the rejection(s) of claim(s) 10 and 19 under Tung et al. (US 5803498) in view of Yuyama et al. (US 5839836) and further in view of Alexander et al. (US 6179202 B1) and Bellesfield et al. (US 6282489 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 6711460 to Reese.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 2, 13, 14, 23, and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6304849 to Uecker et al.

Regarding claims 1, 13, and 23, Uecker et al disclose a system for supplying duplex pharmacy labels comprising (column 5, lines 21-26, lines 41-55):

a sheet, the sheet having an obverse face and a reverse face(column 5, lines 65-67; column 6, lines 1-9, lines 48-57), the obverse face of the sheet including a first area and a second area (Figure 3, first area defined 301 and 301', second area is area surrounding 301 and 301' bounded below by 302 and above by the edges of 201'), the first area of the obverse face including a pair of peel-off labels (Figure 3; 301, 301'; column 6, lines 20-28), the reverse face of the sheet including a first area opposite the first area of the first side (column 6, lines 48-57) ;

a printer, the printer having an input arranged to receive the sheet, the printer further arranged to print on both faces of the sheet (column 5, lines 41-55);

a database, the database including patient specific data for a plurality of patients and medication specific data for a plurality of medications (column 3, lines 48-59; column 4, lines 8-35, lines 36-50); and

a controller, the controller operatively connecting the printer and the database (Figure 2, reference 203; column 5, lines 5-18), the controller arranged to forward patient specific data for a selected patient and medication specific data for a selected medication to the printer to thereby cause the printer to print patient specific data for the selected patient and medication specific data for the selected medication on the pair of peel-off labels of the first area of the obverse face and on the first area of the reverse face (column 5, lines 19-40; column 6, lines 15-27, lines 47-57) and

wherein the sheet is adapted to fold along a pair of fold lines that divide the sheet into first, second and third sections (Figure 4, reference 302, 402; sections 205, 401, 204; column 6, lines 58-67; column 7, lines 1-7), and wherein the first and second area of the obverse face are disposed on the same section (the first and second area as defined above are in the same section 205 as shown in Figure 4).

Further with respect to claim 13, Uecker et al discloses the first area of the obverse face including a pair of peel-off labels removably disposed on a backing surface (column 6, lines 9-15), the reverse face of the sheet including a first area opposite the first area of the first side at least a portion of the first area of the reverse face formed by a reverse face of the backing surface (column 6, lines 48-57).

Regarding claims 2 and 14, Uecker et al teaches all the limitations of claims 1 and 13 respectively. Further Uecker et al discloses the system of claim 1, including a user interface operatively connected to the controller, the user interface enabling a user to input the selected patient and the selected medication (column 3, lines 48-53).

Regarding claim 24, Uecker et al teaches all the limitations of claim 23. Further Uecker et al discloses the method of claim 23, wherein the peel off labels are attached to a backing surface, and wherein at least a portion of the first area of the reverse face formed by a reverse face of the backing surface (column 6, lines 9-16, lines 38-57).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 7, 9, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 5803498 to Tung et al.

Regarding claims 6 and 16, Uecker et al teaches all the limitations of claims 1 and 13 respectively. Further Uecker et al discloses the system of claim 1, wherein the sheet comprises a standardized form, at least a portion of the form containing pre-printed information, the pre-printed information being non-patient specific (column 6, lines 38-47). However Uecker et al does not disclose wherein the information is non-vendor specific.

Tung et al disclose wherein the information is non-vendor specific (Figure 1a, 1b).

Uecker et al and Tung et al are combinable because they are in the similar problem area of printing pharmaceutical information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the non-vendor information of Tung et al with the system of Uecker et al to implement non-vendor information labeling.

The motivation to combine the reference is clear because it provides the patient with alternative information which might be of interest such as for advertising purpose(column 1, lines 60-65).

Regarding claim 7, Uecker et al teaches all the limitations of claim 1. Further Tung et al disclose the system of claim 1, wherein a portion of the pre-printed information is in landscape format (Figure 1a, reference 18; Figure 1b, reference 42)

Regarding claims 9 and 18, Uecker et al teaches all the limitations of claims 1 and 13 respectively. Further Tung et al disclose the system wherein at least a portion of the medication specific data on the reverse face is printed in landscape format and extends across the first area/backing of the reverse face and at least a portion of the second area of the reverse face (Tung et al: Figure 2a; column 5, lines 7-12; Uecker et al: column 6, lines 12-16, lines 48-57).

7. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 6161871 to Richardson.

Regarding claims 8 and 17, Uecker et al teaches all the limitations of claims 1 and 13 respectively. However Uecker et al does not disclose a system, wherein the patient specific data and the medication specific data are printed in landscape format on one of the faces and in portrait format on the other of the faces.

Richardson discloses printed in landscape format on one of the faces and in portrait format on the other of the faces (Figures 2, 3; column 1, lines 50-55; 20 is landscape mode and 18 is portrait mode).

Uecker et al and Richardson are combinable because they are in the similar problem area of printing information.

It would have been obvious at the time of the invention for one skilled in the art to combine the printing format of Richardson with Uecker et al to implement different print format for first and second faces of the pharmaceutical label.

The motivation for doing so would be to provide different orientations for printing the label.

8. Claims 10, 19, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 6711460 to Reese.

Regarding claims 10 and 19, Uecker et al discloses a system for supplying duplex pharmacy labels comprising:

a sheet, the sheet having an obverse face and a reverse face (column 5, lines 65-67; column 6, lines 1-9, lines 48-57), the obverse face of the sheet including a first area and a second area (Figure 3, first area defined 301 and 301', second area is area

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surrounding 301 and 301' bounded below by 302 and above by the edges of 201'), the first area of the obverse face including a pair of peel-off labels (Figure 3; 301, 301'; column 6, lines 20-28), the reverse face of the sheet including a first area opposite the first area of the first side (column 6, lines 48-57);

a printer, the printer having an input arranged to receive the sheet, the printer further arranged to print on both faces of the sheet (column 5, lines 41-55);

a database, the database including patient specific data for a plurality of patients and medication specific data for a plurality of medications (column 3, lines 48-59; column 4, lines 8-35, lines 36-50); and

a controller, the controller operatively connecting the printer and the database (Figure 2, reference 203; column 5, lines 5-18); the controller arranged to forward patient specific data for a selected patient and medication specific data for a selected medication to the printer to thereby cause the printer to print patient specific data for the selected patient and medication specific data for the selected medication on the first area of the obverse face and on the first area of the reverse face (column 5, lines 19-40; column 6, lines 15-27, lines 47-57).

Further with respect to claim 19, Uecker et al discloses the first area of the obverse face including a pair of peel-off labels removably disposed on a backing surface (column 6, lines 9-15), the reverse face of the sheet including a first area opposite the first area of the first side at least a portion of the first area of the reverse face formed by a reverse face of the backing surface (column 6, lines 48-57).

However Uecker et al does not disclose wherein the database includes location-specific data associated with the selected medication for a plurality of store locations, the controller arranged to forward location specific data associated with the selected medication for a selected store location to the printer to thereby cause the printer to print the location-specific data for the selected store location on at least one of the obverse face and the reverse face.

Reese discloses the database includes location-specific data associated with the selected medication for a plurality of store locations (column 5, lines 57-61; column 6, lines 15-24), the controller arranged to forward location specific data associated with the selected medication for a selected store location to the printer to thereby cause the printer to print the location-specific data for the selected store location on at least one of the obverse face and the reverse face (column 8, lines 21-28; column 9, lines 31-43; column 19, lines 25-33; column 22, lines 13-18).

Uecker et al and Reese are combinable because they are in the similar problem area of printing pharmaceutical information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the database of Reese with the system of Uecker et al to implement location-specific printing for pharmaceutical products.

The motivation to combine the reference is clear because Reese teaches that the pharmacist can operate remotely and efficiently using the system (column 2, lines 22-47).

Regarding claim 25, Uecker et al teaches all the limitations of claim 23. Further Uecker et al discloses the method of claim 23, wherein the database includes location-specific data for a plurality of store locations, and including the steps of selecting a store location and forwarding the location-specific data for the selected store location to the printer, and printing the location-specific data on at least one of the obverse face and the reverse face (see Reese disclosure above).

Regarding claims 28 and 29, Uecker et al in view of Reese teach all the limitations of claims 10 and 19 respectively. Further Reese discloses the system of claim 10, wherein the location-specific data associated with the selected medication for a plurality of store locations comprises a location within a pharmacy store in which the selected medication is located (column 17, lines 48-67).

9. Claims 11, 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 6240394 to Uecker et al.

Regarding claims 11, 20, and 26, Uecker '849 et al teach all the limitations of claims 1, 13, and 23 respectively. However Uecker et al '849 does not disclose the system wherein the database includes a message data comprising a plurality of messages, the controller arranged to forward a selected message to the printer the thereby cause the printer to print the selected message on at least one of the obverse face and the reverse face.

Uecker et al '394 discloses the system wherein the database includes a message data comprising a plurality of messages, the controller arranged to forward a

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selected message to the printer the thereby cause the printer to print the selected message on at least one of the obverse face and the reverse face (column 4, lines 30-40).

Uecker et al '849 and Uecker et al '394 are combinable because they are in the similar problem area of printing pharmaceutical information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the message printing of Uecker et al '394 with system of Uecker et al '849 to implement select message printing for pharmaceutical products.

The motivation to combine the reference is clear because using the system of Uecker et al '394 prescription receiving customers can get useful information related to the medication (column 4, lines 12-18).

10. Claims 12, 21, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6304849 to Uecker et al in view of U.S. Patent No. 6240394 to Uecker et al further in view of US 2002/0092019 A1 to Marcus.

Regarding claims 12, 21, and 27, Uecker et al (6304849) in view of Uecker et al (6240394) teach all the limitations of claims 11, 20, and 26 respectively. Further Uecker et al (6240394) disclose wherein the message is store-specific level (column 4, lines 13-19; The coupons are to be used in a store.). However Uecker et al in view of Uecker et al does not disclose the system wherein the message data comprises a plurality of message levels, the message levels including a default level, a date-specific level, and a geographic-specific level.

Marcus discloses the system wherein the message data comprises a plurality of message levels, the message levels including a default level, a date-specific level, and a geographic-specific level (page 7, paragraph 102; page 30 paragraph 467; page 1, paragraph 1).

Uecker et al '849, Uecker et al '394, and Marcus are combinable because they are in the similar problem area of label printing (Marcus: paragraph 423).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the message level system with the system of Uecker et al '849 in view of Uecker et al '394 to implement message level used for printing labels.

The motivation to combine the reference is clear because level can be used for defining the amount of message a user will receive in terms of advertising according to Marcus (page 7, paragraph 102-116).

Regarding claim 22, Uecker et al in view of Uecker et al further in view of Marcus teach all the limitations of claim 21. Further Marcus discloses wherein the system of claim 21, wherein the plurality of message levels are prioritized (page 7, paragraph 101, 102, 103-116).

Other Prior Art Cited

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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U.S. Patent No. 6036231 to Foote et al discloses labeling for pharmacy products.

U.S. Patent No. 6715796 to Foote et al discloses labeling for pharmacy products.

U.S. Patent Application Publication Pub. No. US 2006/0229940 A1 to Grossman discloses advertising system.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone

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number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

12/09/2006

KAWilliams
KAWILLIAMS
PATENT EXAMINER